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10/600,527	06/23/2003	Yasuhito Watanabe	D-1504	7555

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EXAMINER
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MORRISON, THOMAS A

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/600,527

Applicant(s)

WATANABE ET AL.

Examiner

Thomas A. Morrison

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicants' claim for foreign priority based on an application filed in Japan on June 24, 2002. It is noted, however, that applicants have not filed a certified copy of the Japanese application as required by 35 U.S.C. 119(b). In order to perfect priority, applicants should file a certified copy of the original foreign application, specification, and drawings upon which it is based, and file a translation.

### ***Claim Objections***

2. Claims 1 and 5 are objected to for the following informalities: (a) in claim 1, line 10, "plate" should be -- platen --; and (b) in claim 5, lines 5-6, "first the transport means" should be -- the first transport means --.

### ***Claim Rejections – 35 USC§112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

In particular, claim 1 and its dependent claims 2-11 require regulating means for forming a space with a predetermined distance to the platen roller in a direction away from the platen roller. Also, claim 14 and its dependent claim 15 require regulating

means for forming a space with a predetermined distance at a side opposite to the guide means. It is unclear where the space is located. In other words, it is unclear what two elements the space is located between in independent claims 1 and 14.

Regarding claim 3, this claim requires that the platen roller be disposed at a position away from the reading position in a direction that the platen roller transports the original. However, the instant application appears to disclose that an original is transported from left to right as shown in Fig. 2, and a platen roller 27 is located to the left of the reading position X. In other words, platen roller 27 is disposed away from the reading position in a direction **opposite** to the direction that the platen roller transports the original. As such, the position of the platen roller is unclear in claim 3.

Also, claim 4 contradicts the limitations of claim 3, because it requires the platen roller to be disposed at an upstream side of the reading position. In other words, claim 4 contradicts the requirement in claim 3 for the platen roller to be disposed at a position away from the reading position **in a direction that the platen roller transports the original**.

Regarding claims 5 and 6, claim 5 requires first transport means disposed at the upstream side of the platen roller **in the direction** that the platen roller transports the original. However, the instant application appears to disclose first transport means (transfer rollers 28) disposed to the left of platen roller 27 in a direction **opposite** to the direction the platen roller transports the original. Thus, the location of the first transport means is unclear.

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Regarding claim 12 and its dependent claim 13, claim 12 recites the limitation "the guide means" in line 11. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-7, 11 and 14-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishikata et al. In particular, Nishikata et al. discloses all of the limitations set forth in claims 1-7, 11 and 14-15.

Regarding claim 1, Figs. 1-12 show an automatic document feeder (30) for feeding an original, including a reading portion (near Q) having a reading position (Q) for reading the original;

a platen roller (11) for transporting the original at the reading portion (near Q);  
guide means (including 14 and 23) arranged relative to the platen roller (11) to form a curved original path together with the platen roller (11);

regulating means for forming a space with a predetermined distance to the platen roller (11) in a direction away from the platen roller (the document feeder 30 is configured such that there is a space between the platen roller 11 and a platen 62. In

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other words, document feeder 30 includes structure that forms a space with a predetermined distance to the platen roller 11 in a direction away from the platen roller 11, which can be considered to be regulating means); and

pressing means (24) for pressing the guide means (including 14 and 23) to the platen roller (11) so that the original moves the guide means (including 14 and 23) toward a side opposite to the platen roller (11) when the original enters between the platen roller (11) and the guide means (including 14 and 23).

Regarding claim 2, Fig. 10 shows a platen (62) at which the reading portion (near Q) is disposed, the guide means (including 14 and 23) is located between the platen (62) and the platen roller (11), and the regulating means forms a space between the platen roller (11) and the platen (62). Specifically, Fig. 10 shows that the guide means (including 14 and 23) is located between the top of platen roller (11) and the top of the platen (62).

Regarding claim 3, as best understood from the drawings of the instant application, Nishikata et al. also discloses that the platen roller (11) is disposed at a position away from a reading position (Q) in a direction that the platen roller (11) transports the original.

Regarding claim 4, as best understood from the drawings of the instant application, Nishikata et al. also discloses that the platen roller (11) is disposed at an upstream side of the reading position (Q) in the direction that the platen roller (11) transports the original.

Regarding claim 5, as best understood from the drawings of the instant application, Nishikata et al. also discloses first transport means (7) disposed at the upstream side of the platen roller (11) in the direction that the platen roller (11) transports the original for transferring the original to the reading position (Q), and the platen roller (11) is disposed between the first transport means (7) and the reading position (Q).

Regarding claim 6, Fig. 10 shows second transport means (15) for transferring the original transported by the platen roller (11) from the reading position (Q).

Regarding claim 7, Figs. 1-12 show that the guide means (including 14 and 23) is formed in a flexible transparent film member.

Regarding claim 11, Figs. 1-12 show that the platen roller (11) is supported at a predetermined position above the platen (62).

Regarding claim 14, Figs. 1-12 show an automatic document feeder (30) for feeding an original, including

a reading portion (near Q) having a reading position (Q) for reading the original;

transport means (11) for transferring the original to the reading position (Q) of the reading portion (near Q);

backup guide means (13a) arranged along a direction that the transport means (11) transports the original;

guide means (including 14 and 23) situated adjacent to the backup guide means (13a) to form an original reading path together with the backup guide means (13a);

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regulating means for forming a space having a predetermined distance at a side opposite to the guide means (including 14 and 23) (i.e., the document feeder 30 is configured such that there is a space between the guide means (including 14 and 23) and a platen 62. In other words, the document feeder 30 includes structure that forms a space with a predetermined distance at a side opposite to the guide means (including 14 and 23), which can be considered to be regulating means); and

pressing means (24) for pressing the guide means (including 14 and 23) against the backup guide means (13a) so that the original moves the guide means (including 14 and 23) toward the side opposite the guide means when the original enters between the backup guide means (13a) and the guide means (including 14 and 23). No function is recited for the backup guide means. As such, the guide means 13a in Fig. 10 of Nishikata et al. is considered to be a backup guide means as claimed.

Regarding claim 15, Figs. 1-12 show a platen (62) at which the reading portion (near Q) is disposed and show that the backup guide means (13a) is arranged to face the platen (62). Also, Figs. 1-12 show that the guide means (including 14 and 23) is arranged between the platen (62) and the backup guide means (13a). In addition, Figs. 1-12 show that the regulating means forms a space between the backup guide means (13a) and the platen (62).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikata et al. as applied to claim 1 above, and further in view of Lin. In particular, Nishikata et al. discloses all of the elements, except for the guide member movable freely for pressing the original against the guide means at the reading position.

Lin discloses that it is well known to use a guide member (50, 502) movable freely for pressing an original against a guide means (144) at a reading position, so that wrinkles are removed from the original via the guide member to improve image reproduction. It would have been obvious to one of ordinary skill in the art at the time of the invention, to provide the document feeder of Nishikata et al. with a guide member that presses the original against the guide means, to remove wrinkles and improve image reproduction, as taught by Lin.

#### ***Allowable Subject Matter***

6. Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, and also amended to overcome the rejection under 35 U.S.C. 112, second paragraph.

#### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

U.S. Patent No. 6,219,511 (Okada) discloses a document feeder with a platen roller and a flexible film member;

U.S. Patent Nos. 5,816,569 (Hoshi et al.) and 5,887,866 (Yamauchi et al.) disclose document feeders with platen rollers and transparent flexible guide members;


U.S. Patent No. 6,076,822 (Baba et al.) discloses a document feeder with a platen roller and a flexible film member; and

Japanese Publication Nos. 2000327168 and 10236690 disclose document feeders with platen rollers and transparent guide members.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Morrison whose telephone number is 703-305-0554. The examiner can normally be reached on M-F, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
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